

### **REMARKS**

In the Final Office Action<sup>1</sup>, the Examiner rejected claims 1-3 under 35 U.S.C. § 101 as directed to non-statutory subject matter; rejected claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2001/0015721 to Byun et al. ("Byun") in view of U.S. Patent 7,206,599 to Lemley ("Lemley"); and rejected claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,169,984 to Bogdan ("Bogdan").

Applicants propose to amend claims 1-3, 7-9, and 13-15. Support for the claim amendments can be found, for example, at paragraphs 25, 33, and 35 of Applicants' published specification.

### **Interview Summary**

As an initial matter, Applicants would like to thank Examiners Augustine and Theriault for the courtesies extended to Applicants' representative during the telephonic interview of July 23, 2009. During the interview, proposed claim amendments were discussed in view of the outstanding prior art rejections. It was agreed that the proposed claim amendments would overcome the outstanding rejections and the prior art of record. The amendments and remarks herein are consistent with the discussion during the interview.

### **Finality of Office Action**

Initially, Applicants respectfully assert that the Office Action should not have been made final. The MPEP states, a "second or any subsequent actions on the merits shall

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims . . . ." MPEP § 706.07(a). In this case, however, the § 101 issue was raised for the first time in the Final Office Action. Moreover, the § 101 rejection was not "necessitated" by the amendments filed March 20, 2009.

Prior to the amendments filed March 20, 2009, the Office's position was that claims 1-3 were directed to statutory subject matter under § 101, as these claims were not rejected under § 101. In the Final Office Action, however, the Office then changed its position and rejected claims 1-3 under § 101. Accordingly, the Office Action could properly have been made final only if the amendments filed March 20, 2009 somehow changed the claimed subject matter from statutory subject matter to non-statutory subject matter, thereby raising the § 101 issue and "necessitating" the § 101 rejection.

At page 2, the Office Action states, "As for claims 1-3, the method described is not of a tie to another class of invention . . . the method claim does not transform any physical article to a different state or thing." The Office Action does not, however, articulate its position as to how the amendments filed March 20, 2009 converted the claimed subject matter to non-statutory subject matter, thus raising the § 101 issue and "necessitating" the § 101 rejection. Applicants respectfully note that the amendments did not render the claimed subject matter non-statutory under § 101, and therefore did not "necessitate" the § 101 rejection.

For at least the above reasons, Applicants respectfully submit that the Office Action should not have been made final, and that the proposed amendments filed

herein should be entered as a matter of course, instead of at the discretion of the Examiner.

**Rejection under § 101**

Applicants respectfully traverse the rejection of claims 1-3 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants propose to amend independent claim 1, from which claims 2 and 3 depend, to recite "[a] method performed by a computer . . . comprising . . . ." Moreover, Applicants also propose to amend claims 1-3 such that the various recited steps are performed by "a processor associated with the computer." Applicants respectfully submit that amended claims 1-3 would therefore be tied to an apparatus in accordance with In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).

Accordingly, Applicants request the withdrawal of the rejection under 35 U.S.C. § 101.

**Rejections under § 103(a)**

Applicants respectfully traverse the rejections of claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byun in view of Lemley.

Amended independent claim 1 recites a method for navigating user interface elements comprising, among other features,

searching . . . the display to identify the parent graphical user interface elements and the sibling graphical user interface elements;

collecting from the display. . . text labels for the identified parent and sibling graphical user interface elements . . . ;

detecting . . . [a] sibling navigation input comprising a sibling navigation key press plus a key press of a first alphanumeric

character . . . and [a] parent navigation input comprising a parent navigation key press plus a key press of a second alphanumeric character . . . ;

when the detected navigation input is the sibling navigation input . . . identifying . . . a sibling group of user interface elements having a text label alphabetically corresponding to the key press of the first alphanumeric character; . . . and

when the detected navigation input is the parent navigation input . . . identifying . . . a parent group of user interface elements having a text label alphabetically corresponding to the key press of the second alphanumeric character.

Byun discloses "a method for searching a menu in a mobile communication terminal." ¶ 2. In Byun, "the plurality of main menu icons 401 are displayed in a horizontal direction . . . and a plurality of sub menus 406 corresponding to each main menu are displayed in a vertical direction . . . ." ¶ 39; and see Fig. 5A. As noted in the Office Action at page 4, Byun discloses, "The left and right shift keys 301 are preferably used for movement between main menus, and the up and down shift keys 302 preferably used key for movement between sub menus." ¶ 33. While Byun may display a plurality of main menus and a plurality of sub menus, Byun does not "search[] . . . the display to identify the parent graphical user interface elements and the sibling graphical user interface elements," and "collect[] from the display . . . text labels for the identified parent and sibling graphical user interface elements," as recited by amended independent claim 1.

Moreover, as discussed above, a user of Byun's mobile terminal navigates horizontally through the main menus using only the left and right shift keys and navigates vertically through the sub menus using only the up and down shift keys. In contrast, amended independent claim 1 recites "detecting . . . [a] sibling navigation input

comprising a sibling navigation key press plus a key press of a first alphanumeric character . . . and [a] parent navigation input comprising a parent navigation key press plus a key press of a second alphanumeric character" (emphasis added). Byun's left and right/up and down shift keys do not comprise "a sibling navigation key press plus a key press of a first alphanumeric character . . . and . . . a parent navigation key press plus a key press of a second alphanumeric character" (emphasis added), as recited by amended independent claim 1. Further, because Byun fails to disclose or suggest the claimed "searching," "collecting," and "detecting" steps of amended independent claim 1, Byun also cannot disclose or suggest "when the detected navigation input is the sibling navigation input . . . identifying . . . a sibling group of user interface elements having a text label alphabetically corresponding to the key press of the first alphanumeric character," and "when the detected navigation input is the parent navigation input . . . identifying . . . a parent group of user interface having a text label alphabetically corresponding to the key press of the second alphanumeric character," as recited by amended independent claim 1.

Lemley fails to remedy the deficiencies of Byun. Lemley discloses a mobile telephone handset that "automatically toggles between the navigation and alphanumeric functions of these keys based on where the user is within the interface routine of the mobile." Abstract. Specifically, "if a menu option is selected that requires numerical or textual data input, navigation keys 10 automatically respond as numerical or textual keys within the alphanumeric mode until the data is entered. Once the data is entered . . . navigation keys 10 automatically return to the navigation mode." Col. 4, ll. 21-24.

Lemley, however, fails to disclose or suggest a combination comprising at least the above-referenced elements of amended independent claim 1.

For at least the above reasons, amended independent claim 1 is allowable over Byun in view of Lemley. Independent claims 7 and 13, though of different scope from claim 1, recite features similar to those discussed above in connection with claim 1, and are thus allowable over Byun in view of Lemley for at least similar reasons as claim 1. Claims 2, 3, 8, 9, 14, and 15 are also allowable at least due to their dependence from one of independent claims 1, 7, and 13. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byun in view of Lemley.

Applicants respectfully traverse the rejection of claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Bogdan.

Bogdan discloses, "[a] user interface control implementing a global keyboard navigation system by way of printable keyboard character input to extend an incremental type search across all window components within a defined scope." Abstract. Bogdan defines "[a] container [having] one or more other components." Col. 5, ll. 28-29. Then, "a search can be limited to the contents of container 250 by defining the scope accordingly." Col. 5, ll. 54-56. While Bogdan may define a container of one or more components, Bogdan does not "search[] . . . the display to identify the parent graphical user interface elements and the sibling graphical user interface elements," and "collect[] from the display. . . text labels for the identified parent and sibling graphical user interface elements," as recited by amended independent claim 1.

As noted in the Office Action at pages 6 and 7, Bogdan discloses, "a recursive search of all parent and child generations occurs to find a match between the first character of keyboard input from the user and the first character of a component name." Col. 7, ll. 27-30. "[T]he recursive search begins with the present component's children and [moves] down through the generations of the children's children." Col. 8, ll. 44-46. "If a match is not found . . . , then the search continues through the child generations of the present component's parent and on up the parent hierarchy until either a match is found, or there are no remaining components to search within the defined scope." Col. 7, ll. 34-38.

Thus, Bogdan discloses only one type of search input that triggers a recursive search of all parent and children components. In contrast, amended independent claim 1 recites "detecting . . . [a] sibling navigation input comprising a sibling navigation key press plus a key press of a first alphanumeric character . . . and [a] parent navigation input comprising a parent navigation key press plus a key press of a second alphanumeric character" (emphasis added). Bogdan does not disclose both the claimed "sibling navigation" **and** "parent navigation" inputs of amended independent claim 1. Further, because Bogdan fails to disclose or suggest the claimed "searching," "collecting," and "detecting" steps of amended independent claim 1, Bogdan also cannot disclose or suggest "when the detected navigation input is the sibling navigation input . . . identifying. . . a sibling group of user interface elements having a text label alphabetically corresponding to the key press of the first alphanumeric character," and "when the detected navigation input is the parent navigation input . . . identifying . . . a parent group of user interface having a text label alphabetically corresponding to the

key press of the second alphanumeric character," as recited by amended independent claim 1.

For at least the above reasons, amended independent claim 1 is allowable over Bogdan. Amended independent claims 7 and 13, though of different scope from claim 1, recite features similar to those discussed above in connection with claim 1, and are thus allowable over Bogdan for at least similar reasons as claim 1. Claims 2, 3, 8, 9, 14, and 15 are also allowable at least due to their dependence from one of independent claims 1, 7, and 13. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 7-9, and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Bogdan.

#### **Conclusion**

Applicants respectfully request that this Amendment be entered under 37 C.F.R. § 1.116. It is respectfully submitted that this Amendment would allow for immediate action by the Examiner, and would place the application in condition for allowance. In the alternative, this Amendment would place the application in a better form for appeal should the Examiner dispute the patentability of the pending claims. Moreover, Applicants respectfully submit that this Amendment should be entered as a matter of course because the Office Action should not have been made final, as discussed above with respect to the § 101 rejection.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is kindly invited to contact the undersigned at 202.216.5118.



Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 7, 2009

/James D. Stein/

By: \_\_\_\_\_

James D. Stein  
Reg. No. 63,782  
202.216.5118